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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WILSON, JOHN J

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,677

Applicant(s)

GUGEL ET AL.

Examiner

John J. Wilson

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3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 32-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 32, lines 2 and 3, the alternative embodiment "or hollow head (53)" is not clearly disclosed because the head 53 does not appear to be an equivalent to the needle and the head is not described as having features as the needle, for example, a bayonet connection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 44, line 2, "said liquid instrument" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 32, 34 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Conger, Sr. (4648840). Conger shows a hand piece 1, handle 4, hollow needle 13, for discharge of abrasive "A", Fig. 2, and fluid, column 4, lines 2-14, coupling terminal 2 connected to a supply line 3 and means 12 for detachably connecting the needle 13, column 4, lines 23-48. Connection 12 is threaded, which is held to be inherently fast acting. As to claim 40, Conger teaches the coupling is for gas, air and therapeutic agent, that is, water, column 3, line 60 through column 4, line 2.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Tilden (2814877). Conger shows the structure as described above, however, while showing a treaded connection at 12, the reference does not show a bayonet connection. Tilden teaches that it is known to use the alternatives of

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treaded or bayonet connections when attaching nozzles, column 4, lines 60-64. It would be obvious to one of ordinary skill in the art to modify Conger to include a bayonet connection as shown by Tilden in order to make use of art known alternatives to best attach a nozzle to an abrasive tool.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Maurer et al (2643456). Conger shows the structure as described above, however, does not show a plurality of needles having different shapes, sizes and opening sizes. Maurer teaches using a plurality of needles having different shapes and opening sizes, Figs. 12-21. It would be obvious to one of ordinary skill in the art to modify Conger to include using a plurality of nozzles as shown by Maurer in order to better apply the abrasive in the desired manner. That different sizes can be used is an obvious matter of choice in the size of known elements to one of ordinary skill in the art in order to best reach desired areas in the mouth of the patient.

Claims 36 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Landgraf et al (4198755). Conger shows the structure as described above, however, does not show rotating sleeves. Landgraf shows using rotating sleeves (22, 23) and 54. It would be obvious to one of ordinary skill in the art to modify Conger to include using rotating sleeves as shown by Landgraf in order to allow for easier positioning of the tool within the mouth of the patient.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Landgraf et al (4198755) as applied to claim 36 above, and further in view of Karst (4950160). Conger shows the structure as described above, and further shows locating the supply at an angle to the longitudinal axis of the hand piece while locating the coupling means on the axis, and as such, does not show reversing the location of these elements. Karst shows locating the coupling means as shown at the bottom of 12, at an angle to the longitudinal axis. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating the coupling means at an angle as shown by Karst in order to choose the desired location of known elements so as to enable a better grip of the instrument. As to claim 38, Karst shows the storage container 18 being located at the rear. The specific location is merely a matter of the location of known elements to the skilled artisan. As to claim 39, the specific relative location of these elements is also an obvious matter of choice in the location of known element to one of ordinary skill in the art.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Saupe et al (4696645). Conger shows the structure as described above, however, does not show arranging the gas feed line at the rear of the therapeutic line. Saupe shows locating feed line 90, Fig. 7, at the rear of feed line 87. It would be obvious to one of ordinary skill in the art to modify Conger to include locating one feed line to the rear of another as shown by Saupe in order to make use of known locations of elements in coupling members to best couple the elements together.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 32-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,416,321. Although the conflicting claims are not identical, they are not patentably distinct from each other because to call the claimed outlet connections of the '321 patent, fast acting is merely a matter of interpretation of the speed at which the connection can be made, and as such, would be an obvious matter of choice in terminology to one of ordinary skill in the art.

Claims 32-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,719,561. Although the conflicting claims are not identical, they are not patentably distinct from each other because to not use a rotatable coupling is an obvious matter of choice in not using elements to one of ordinary skill in the art.

Specification

The specification is objected to because it refers to claims in the description, see page 1. Correction is required.

Drawings

The drawings filed February 23, 2004 have been found to be acceptable by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Black (3882638) and Ghedini et al (4608018) have been cited in parent applications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached at 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John J. Wilson
Primary Examiner
Art Unit 3732

jjw
June 9, 2006